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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/579,780	05/18/2006	Yoshiya Oda	042715-5019	5776
9629 7590 05/27/2009 MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004				
EXAMINER				
GAKH, YELENA G				
ART UNIT		PAPER NUMBER		
1797				
MAIL DATE		DELIVERY MODE		
05/27/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/579,780

**Applicant(s)**

ODA ET AL.

**Examiner**

Yelena G. Gakh, Ph.D.

**Art Unit**

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-117 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-117 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-20 and 25-26, drawn to a method for quantitating a biological molecule.

Group II, claim(s) 21 and 22-24, drawn to an internal standard and a reagent comprising a metabolically isotope labeled biological molecule.

Group III, claim(s) 22, drawn to a cell comprising a metabolically isotope labeled biological molecule.

Group IV, claim(s) 27-30, drawn to a program for causing a computer ... to quantitate biological molecule.

Group V, claim(s) 31-37, drawn to an analysis system for analyzing biological molecules utilizing a waveform.

Group VI, claim(s) 38-48, drawn to an analysis system for analyzing biological molecules using metabolically isotope labeled biological molecule.

Group VII, claim(s) 38-48, drawn to an analysis system for analyzing biological molecules using metabolically isotope labeled biological molecule.

Group VIII, claim(s) 49-55, drawn to an analysis method for analyzing data.

Group IX, claim(s) 56-66, drawn to an analysis method for analyzing data.

Group X, claim(s) 67-73, drawn to a program for causing a computer ... to quantitate biological molecule.

Group XI, claim(s) 74-84, drawn to a program for causing a computer ... to quantitate biological molecule.

Group XII, claim(s) 85 and/or 87-95, drawn to an analysis method for analyzing data.

Group XIII, claim(s) 86 and/or 87-95, drawn to an analysis method for analyzing data.

Group XIV, claim(s) 96-106, drawn to a program for causing a computer ... to quantitate biological molecule.

Group XV, claim(s) 107-117, drawn to a program for causing a computer ... to quantitate biological molecule.

The inventions listed as Groups I-XV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: for those inventions, which comprise utilizing metabolically isotope labeled biological molecules (Groups I-IV, , this common technical feature is known in the art, see e.g. *Zhong et al. (J. Proteom. Research, 2004)*. For those inventions, which comprise waveform processing (Groups V-XIV), this processing is well known in the art, see e.g. *Brock et al. (US 6,300,626, col. 3, lines 59-62)*. Therefore, the inventions do not share any special technical feature, and the restrictions are proper.

2. A telephone call was made to Mark J. Sullivan on 03/23/09 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

3. **Examiner's Note:** the examiner highly recommends the Applicants to make a preliminary amendment to the following claims in response to the restriction requirements:

1. Claims 4-5, 9-11, 13-24, 30, 34-37, 41-45, 47-48, 52-55, 59-63, 65-66, 70-73, 77-81, 83-84, 88-92, 94-95, 99-103, 105-106, 109-114 and 116-117, which will be withdrawn from consideration as improperly multiple dependent claims.

2. Claims 25-26, which will be rejected under 35 U.S.C. 112, second paragraph, and 101, as use claims.

3. All claims directed toward programs, which will be rejected 35 U.S.C. 101 as directed toward non-statutory subject matter. The programs should be associated with the computer medium.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yelena G. Gakh, Ph.D. whose telephone number is (571) 272-1257. The examiner can normally be reached on 9:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vickie Y. Kim can be reached on (571) 272-0579. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Yelena G. Gakh/  
Primary Examiner, Art Unit 1797

5/22/2009